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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,505	07/27/2001	Fabio Cinelli	CM-2016MC	9733

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

LEE, RIP A

ART UNIT PAPER NUMBER

1713

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,505

Applicant(s)

CINELLI ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows a response filed on December 10, 2003. A declaration under 37 C.F.R. 1.132 was submitted by Applicants. Claims 1-14 and 19 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims are 1-11, 13 and 14 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/28014 to Cinelli *et al.* for the same reasons set forth in the previous office action.

5. Claims 1-11, 13 and 14 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/28021 to Cinelli *et al.* for the same reasons set forth in the previous office action.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cinelli *et al.* in view of EP 0 850 649 to Coles *et al.* for the same reasons set forth previously.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cinelli *et al.* in view of WO 96/33683 to Lichstein for the same reasons set forth previously.

Response to Arguments

8. Applicants traverse the rejections from the previous office action. Their arguments have been considered fully, but they are not persuasive.

First, it is noted that the cited references are silent with regard to chemical crosslinking by low energy irradiation, and examiner concurs. In fact, this deficiency was acknowledged and delineated clearly in the previous office actions. However, Applicants have drawn attention from the fact that the present claims appear in product-by-process format. And in situations where product-by-process claims are rejected over a prior art product that appears to be the same, it is incumbent upon Applicants to establish an unobviousness difference, even if the production processes are different.¹ In other words, Applicants bear the burden of showing how the mode of crosslinking results in a difference structurally or functionally. To date, Applicants have not met this burden of proof.

Dr. Goldman's declaration has been considered. The premise of his argument is that the prior art does not require adhesives to adhere to wet skin. While this may be the gist of the present invention, it does not address issues regarding the claimed features of the invention. Comment is made that the prior art teaches a macromolecular component, but this feature is not excluded in the language of the present claims. That crosslinks are "present preferably in quantities up to 5 % by weight" would appear to satisfy the minimum requirement of the present claims that there is "at least partial" crosslinking. Each of Dr. Goldman's statements have merit, but each fails to establish non-obviousness with respect to the rejection of present claims.

¹*In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

Elucidation will be provided below in response to Applicant's comment that one is "at a loss" to understand how the references can be used to maintain a rejection under 35 U.S.C. 102(a).

First, the office action of Paper No. 6 is not germane to the current rejection because claims were amended by Applicants. As such, the new rejection of subsequent Paper No. 10 reflects these amendments. It is because of amended claims that successive office actions do not share the same bases of rejection.

Secondly, rejections were made under 35 U.S.C. 102(a)/103,² not 35 U.S.C. 102(a) alone. The present claims are drawn to an adhesive which is comprised of polymer and plasticizer. Also, the adhesive is a hydrophilic-hydrophobic mixed phase adhesive. Cinelli *et al.* discloses these items in the appropriate ratios, and therefore, the composition is met by the teachings in the prior art, *i.e.*, 102(a) subject matter. What are not discussed are the physical properties of the material. This falls under 103(a) subject matter. In such instances, the burden of proof rests with the Applicants to establish any unobviousness differences showing that the prior art material would not exhibit the properties in question.³ To date, Applicants have not presented any showing of non-obviousness to buttress their arguments.

The final aspect of the claims was discussed above, and that is the product-by-process limitation. Again, Applicants have not met this burden of proof in showing unobviousness over their invention and that of the prior art *with respect to the mode of crosslinking*.

² *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

³ *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); see also MPEP § 2112.

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In view of the discussion above, the rejections of record have not been withdrawn.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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February 2, 2004


DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700